

### **REMARKS**

This is a response to the non-final Office Action of September 1, 2004. Through this response, claim 3 is cancelled without prejudice, waiver, or disclaimer, leaving claims 1, 2 and 4-14 remain pending in the application. Claims 1, 4, 5 and 11 are amended as indicated. It is believed that the foregoing amendments and additions add no new matter to the instant application.

In the Office Action, there are objections to the Abstract, rejections to claims under 35 U.S.C. §102(b), and rejection to claims under 35 U.S.C. §103(a). The Applicant respectfully requests that there be reconsideration of the claims in view of the Applicants' remarks.

### **Reconsideration of IDS**

Applicants respectfully request that 2 references stricken through the IDS submitted on September 25, 2003 be considered prior to the next office communication concerning this application as agreed upon by the Examiner Hartmann in a telephone conversation on Sept. 29, 2004. Copies of the PTO 1449 forms have been attached for your reference.

### **Rejections Under 35 U.S.C. §102(b)**

Claims 1, 2 and 9-12 stand rejected under 35 U.S.C. 102(b) as being anticipated in view of *Manning* (U.S. 6,074,693). The Applicants respectfully request that the amendment being filed herewith be entered and that there be reconsideration of the claims.

With regard to rejected independent claims 1, Applicants respectfully traverse the Office Action allegation of anticipation of the present invention. In particular, Applicants

assert that while *Manning* may disclose a painting apparatus, *Manning* fails to teach or suggest “a position determining system comprising a laser based electronic distance measuring device”, as now claimed. It is clear that *Manning* uses only GPS for “a current geographical location determined by GPS receiver” (col. 2 lines 26-32,). The Applicants contend that the utilization of GPS to determine a location match for a painting apparatus is completely different than the present invention utilizing a laser based electronic distance measuring device for a painting apparatus. Therefore, Applicants respectfully traverse the Office Action assertion that *Manning* teaches the elements of the present invention as now claimed.

In addition, Applicants respectfully assert that *Manning* fails to teach or suggest “a laser based electronic distancing measuring device including a base station and a reflector”, as now claimed. As stated above, Applicants respectfully assert that *Manning* teaches away from this element by utilizing only GPS for determining the current geographical location of the painting apparatus (col. 2 lines 26-32). “A reference may be the to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicants ... in general, a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicants.” *In re Gurley*, 2 F.3d 551, 31 U.S.P.Q.2d 1130, 1131 (Fed Cir. 1994). Consequently, Applicants respectfully traverse the Office Action assertion that *Manning* teaches the elements of the present invention as now claimed.

These aspects of the present invention, as recited in claim 1, clearly are neither taught nor suggested by *Manning*. Therefore, Applicants assert that *Manning* does not show or suggest all the elements of the claimed invention as required by “*In re Royka*, 490 F.2d

981,180 USPQ 580 (CCPA 1974)”, and any rejection to render claim 1 obvious is inadequate and therefore should be withdrawn.

Claims 2 and 9-12 are dependent upon claim 1, which are believed to be allowable over the prior art made of record. Therefore, these claims are allowable as a matter of law. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

### **Rejections Under 35 U.S.C. §102(b)**

Claims 1-6 and 11-13 stand rejected under 35 U.S.C. 102(b) as being anticipated in view of *Goyet* (U.S. 4,677,555). The Applicants respectfully request that there be reconsideration of the claims as amended.

With regard to rejected independent claims 1, Applicants respectfully traverse the Office Action allegation of anticipation of the present invention in view of *Goyet*. In particular, Applicants submit that *Goyet* describes a method and equipment for automatic guidance of earthmoving machines for excavation work, and more particularly, for laying drainage elements (Title, and column 1, lines 9-12). In addition, Applicants contend that *Goyet* further describes in detail that earthmoving machines are for burying drains in the ground for catching excess water (column 1, lines 13-27; column 3, lines and 55-66).

Therefore, Applicants respectfully submit that *Goyet* fails to teach or suggest **“controllable marking system for marking a sign on the ground”**, as now claimed. It is clear that *Goyet* only describes the guidance of the earth moving machines for forming **burrows in the ground for laying drainage elements.”** (col. 2 lines 45-52,). Nowhere can Applicants find any description of an automatic ground marking apparatus of the present invention, as now claimed.

In addition, Applicants respectfully assert that *Goyet* fails to teach or suggest “a laser based electronic distancing measuring device”, as now claimed. Applicants respectfully assert that *Goyet* teaches away from this element by utilizing a rotating laser beam to control the height of the earthmoving tool (column 2, lines 33-44). *In re Gurley*, 2 F.3d 551, 31 U.S.P.Q.2d 1130, 1131 (Fed Cir. 1994).

Furthermore, Applicants respectfully assert that *Goyet* fails to teach or suggest “a laser based electronic distancing measuring device including a base station and a reflector”, as now claimed. As stated above, Applicants respectfully assert that *Goyet* teaches away from this element by utilizing fixed beacons on the ground (column 2, lines 33-44), instead of the base station and reflector as now claimed.

These aspects of the present invention, as recited in claim 1, clearly are neither taught nor suggested by *Goyet*. Therefore, Applicants assert that *Goyet* does not show or suggest all the elements of the claimed invention as required by “*In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)”, and any rejection to render claim 1 obvious is inadequate and therefore should be withdrawn.

Claims 2-6 and 11-13 are dependent upon claim 1, which is believed to be allowable over *Goyet*. Therefore, these claims are allowable as a matter of law. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

### **Rejections Under 35 U.S.C. §103(a)**

Claims 7 and 8 stand rejected under 35 U.S.C. 103(a) as being unpatentable in view of *Goyet* (U.S. 4,677,555) or *Manning* (U.S. 6,074,693) as applied above. The Applicants respectfully request that there be reconsideration of the claims as amended.

With regard to rejected dependent claims 7 and 8, Applicants respectfully traverse the Office Action allegation of obviousness, because there is no motivation expressed or implied

to modify the teaching of the marking system of *Manning* or *Goyet* to make the claimed invention obvious. The Office Action alleges that one of ordinary skill in the art would be motivated to modify the teachings of either because it is obvious to use a compass in applications requiring specific spatial relationships. **Applicants respectfully disagree that either *Manning* or *Goyet* imply the combination suggested by the Office Action for the reason that neither teach a compass or a processing device responsive to the compass to determine an actual bearing of the carriage, as claimed.**

Therefore, the Applicants submit that there is no teaching or suggestion to modify either *Manning* or *Goyet* in the manner described in the Office Action. "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780 (Fed Cir. 1992).

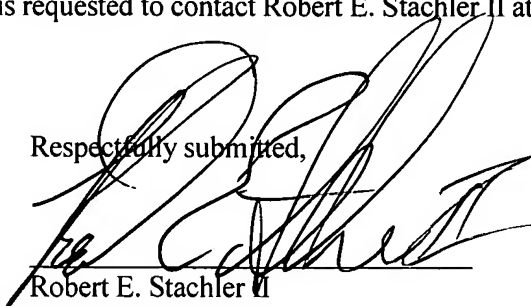
#### **Other References Cited in the Action**

In addition to the references applied in the Office Action, it is respectfully submitted that Applicant's invention, as now recited in claims 1, 2 and 4-14 is neither anticipated nor rendered obvious by any of the other references cited in the Office Action, either taken alone or in combination.

**CONCLUSION**

For at least one of these reasons, Applicant respectfully submits that claims 1, 2 and 4-14 are in condition for allowance and such action by the Examiner is earnestly solicited. If the Examiner has any questions, the Examiner is requested to contact Robert E. Stachler II at (202) 973-2622.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Robert E. Stachler II', is written over a horizontal line.

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